UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,311	06/19/2001	Steven B. Adler	AUS920010589US1	6894

			EXAMINER
50170	7590	05/26/2006	HO, THOMAS M

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ART UNIT	PAPER NUMBER
2134	

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
	09/884,311	ADLER ET AL.
Office Action Summary	Examiner	Art Unit	
	Thomas M. Ho	2134	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>15 March 2006</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-17,19,21 and 22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>4-11</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

1.   Claims 1-20 are pending.

2.   The amendment of 3/15/06 has been received and entered.

3.   Claims 1-3, 12-17, 19, 21, 22 are allowable.

Response to arguments

4.   Applicant has argued:

Paragraph 2, page 11 of 21

"Nowhere in Martin is there any teaching or suggestion of a methodology in a data processing

system for analyzing an information handling process, constructing a model of the information

handling process, or generating an output that identifies at least one way in which personally

identifiable information can be better handled by the information handling process."

The Examiner disagrees with the Applicant's contention.

the reference relied upon, page 59-60 explicitly states that "we analyze systems" by building a

model for object oriented analysis. It is noted that anything that handles information may be

considered an information handling process.

Applicant's arguments appear to repeat the position from the previous actions and are general

allegations that Martin simply doesn't disclose any aspect of any part of the claim. The

Examiner has found these arguments unconvincing. With respect to these allegations, the

Examiner has illustrated his position below in the rejections.

As per Applicant's amended claims 1-3, 12-17, 19, 21, 22 it is the Examiner's position that such

amendment has overcome the rejections and the art of record, and accordingly claims 1-3, 12-17,

19, 21, 22 have been allowed.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and
distinctly claiming the subject matter which the applicant regards as his invention.*

Claims 4-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Applicant's claim 5 recites

*The method of claim 4, wherein said providing output further comprises identifying at least one
way in which said information-handling process could be improved.*

The Examiner contends that the Applicant has merely claimed a "potential".

The claim does not recite "at least one way in which said information-handling process *can*

definitively be improved" but recite "at least one way in which said information-handling process

could be improved"

Likewise, claim 4 recites that output be provided for the purpose in which personally identifiable

information *could* be better handled.

One of ordinary skill in the art would understand that a better understanding of the objects in

question which applicant has conceded is a tool in which a programmer may use as a tool to

understand how objects work with each other is in fact a way in which the information handling

process *could be improved.*

Nevertheless, claims 4 and 5 are indefinite because it fails to identify the specific steps in which

an information process could be improved or better handled. Left to itself, it would appear that

any set of actions may be construed as having the potential to improve the information handling

process, or rather is a method in which such a process "could" be improved.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

7.   Claims 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Martin,

"Principles of Object Oriented Analysis and Design" (hereafter Martin).

In reference to claim 4:

(Martin, "Principles of Object Oriented Analysis and Design") discloses the method, in a data

processing system, for improving the handling of personally identifiable information, said

method comprising:

- Performing, in the data processing system, an initial assessment of an information

  handling process, where the initial assessment is the analysis of the system to be modeled

  in an Object oriented process.   (pages 59-60, "Models of Reality")

- Constructing, in said data processing system, a model of said information handling

  process, based on said initial assessment, where the model of said information handling

  process is performed once an analysis has been made.   (pages 59-60, "Models of

  Reality")

- Providing output, from said data processing system, based on said initial assessment and

  constructing, that identifies at least one way in which said personally identifiable

  information could be better handled, where a particular technique in the refinement of the

  object model is the practice of using CRC cards to gain a better understanding about how

  to handle the model at hand. (Pages 187-190, "Responsibility driven design")

- Wherein said constructing includes:

- Representing entities, data, and rules in said information handling process by using a

  limited number of object classes, where objects represent entities, where the data are

attributes of objects, and where rules are functions that typify the interaction between

objects. (page 156, "models and diagrams") & (page 140, center diagram, 146-147,

Diagrams) & (page 166)

- Representing operations performed on data by using a limited number of privacy-related

    actions, where the active entities are the objects themselves, and the privacy related

    actions-representing operations performed on data are the operations used to read and

    manipulate data of the object. (page 19, "operations")

- Representing transactions by using said limited number of object classes and said limited

    number of privacy-related actions, where the transactions are interactions between the

    modeled objects, (Page 118, "Events triggers and Operations") and the request for data is

    a privacy related action. (page 19, "operations")

Martin has not explicitly called the actions performed within, "privacy related actions".

The Examiner notes that Applicant has defined what privacy related actions are in the

specification. On page 19 of the specification, Applicant defines some privacy related actions

including "access" to grant access to read the user's information. For this reason, the Examiner

has defined similar operations in Martin as "privacy related actions"

In reference to claim 5:

(Martin, "Principles of Object Oriented Analysis and Design") discloses the method of claim

wherein said providing output further comprises identifying at least one way in which said

information-handling process could be improved, where a particular technique in the refinement

of the object model is the practice of using CRC cards to gain a better understanding about how

to handle the model at hand. (Pages 187-190, "Responsibility driven design")

In reference to claim 6:

(Martin, "Principles of Object Oriented Analysis and Design") discloses the method of claim 4,

wherein said providing output further comprises identifying at least one way to improve

compliance with a law or contract, where the CRC method is a technique for better identifying

responsibilities of the objects(page 188, "responsibilities and collaborators"), and it is known in

the art that groups responsibilities are contracts. (page 191, "contracts")

Claims 7, 9 are rejected for the same reasons as claim 5.

In reference to claim 8:

(Martin, "Principles of Object Oriented Analysis and Design") discloses the method of claim 4,

further comprising designing a modification to said information-handling process, based on said

constructing and providing, where modifications are constantly being designed in the creation of

the object oriented model of the system from the creation of the model, to the creation of its

design, to the generation of the code. (page 60)

In reference to claim 10:

(Martin, "Principles of Object Oriented Analysis and Design") discloses the method of claim 1,

wherein said object classes include one or more object classes representing parties, selected from

the group consisting of

- A data user object class, where the student is the data user object class. (Page 158)

- A data subject object class, where the subject object class is the class. (page 158)

- A guardian object class, where the guardian object class is a stock withdrawal subsystem. (page 194)

- A privacy authority object class, where the privacy authority class is a server class. (page 192)

In reference to claim 11:

(Martin, "Principles of Object Oriented Analysis and Design") discloses the method of claim 1,

wherein said at least one object class, having said rules associated with said data. (page 144,

"Object Structure Analysis/ Object Behavior Analysis")

(Martin, "Principles of Object Oriented Analysis and Design") fails to explicitly disclose

representing the rules as a filled paper form, including both collected data and rules regarding

said collected data.

(Martin, "Principles of Object Oriented Analysis and Design") does however disclose that rules

may be written in the English Language. (page 133-134, "Rules Expressed in English"). Martin

discloses more rules on pages (138-139, Box 10.1 & 10.2)

The Examiner takes official notice that representing the rules as a filled paper form, including

both collected data and rules regarding said collected data was well known in the art at the time

of invention. An example of this is a contract signed by certain parties.

It would have been obvious to one of ordinary skill in the art at the time of invention to collect

rules as a filled paper form.

Conclusion

8.   THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy

as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of the final action and the advisory action is not mailed under after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension pursuant to 37 CFR

1.136(A) will be calculated from the mailing date of the advisory action. In no event, however,

will the statutory period for reply expire later than SIX MONTHS from the mailing date of this

final action.

9.   Any inquiry concerning this communication from the examiner should be directed to

Thomas M Ho whose telephone number is (571)272-3835. The examiner can normally be

reached on M-F from 9:30 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor,

Jacques Louis-Jacques can be reached on (571)272-6962.

The Examiner may also be reached through email through **Thomas.Ho6@uspto.gov**

Any inquiry of a general nature or relating to the status of this application or proceeding should

be directed to the receptionist whose telephone number is (571)272-2100.

| General Information/Receptionist | Telephone: 571-272-2100 | Fax: 571-273-8300 |
| Customer Service Representative | Telephone: 571-272-2100 | Fax: 571-273-8300 |

TMH

May 20th, 2006